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| EXAMINER |
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HEWITT II, CALVIN L

| ART UNIT | PAPER NUMBER |
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3621

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,534

Applicant(s)

VAN HORNE ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 39-82 have been examined.

Response to Amendments/Arguments

2. According to the MPEP, language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Similarly, language that describes aspects of a structure in terms of what may or may not be done will not distinguish the claimed structure from the prior art, and such language has been held to be indefinite (*In re Collier*, "means for... upon", 158 USPQ 266 (CCPA 1968)).

The following assertions of fact have gone unchallenged and are considered admitted prior art:

- "pushing" data and "updating" software

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 39-54, 58-73, 77, 78, 80 and 81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 39, 43, 46, 50, 58, 62, 65, 69, 77, 78, 80 and 81 recite conditional language. Claims 39, 46, 58, 65, 78, 80, and 81 recite "if an approve signal is provided", while claims 43, 50, 62, and 69 recite the Applicant's system performing specific actions "if the client system has proper network configuration and registry settings to accomplish communication with the electronic network". Claims 39, 43, 46, 50, 58, 62, 65, 69, 78, 80, 81 and 82, each recite "if a previous session" or similar language. Conditional language inherently comprises at least two conditions: the "if" and the "if not". The Applicant's claims, however, are silent regarding how Applicant's system is to perform if the "if not" condition holds. Therefore, one of ordinary skill is hindered from determining the scope and how to use said system.

For purposes of examination, with regard to these claims, the Examiner is considering the "if not" case. For example, claims 50, 62, and 69 recite performing particular steps "if the client has proper network configuration and registry settings to accomplish communication with the electronic network". However, that is predicated on the client receiving an "approval signal" (see claims 39, 58, 65). As stated above, the Examiner is

considering the “if not” case therefore, a rejection signal is received and therefore, claims 50 and 62 do not occur.

Claims 40-42, 44, 45, 47-49, 51-54, 51-57, 59-61, 63, 64, 66-68, and 70-73 are also rejected because they depend from claims 39, 43, 46, 50, 58, 62, 65 or 69.

b. Claim 44 recites “sending a periodic signal connect signal to the server system confirming that the client system is still connected”.

However, claim 39, from which claim 44 depends, does not refer to the client system making a “connection”. Claim 63 recites a similar limitation.

c. Claims 58, 65, 74, and 77-82 are directed to structure. However, claimed features of the structure are recited using method or process steps (e.g. “said client system...”, “client software configured for...”). It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548).

Claims 59-64, 66-73, 75 and 76 are also rejected as each depends from either claim 58, 65, 74, and 77-82.

d. Claims 58, 65, 74, and 77-82 are directed to structure. However, claimed features of the structure are recited in terms of what may or may not be done (e.g. "*if a previous session using said client software completed unsuccessfully*", "*upon said client system completing initialization wherein if a previous session using said client software completed unsuccessfully*"). It has been held (*In re Collier*, "means for... upon", 158 USPQ 266 (CCPA 1968)) that claims that describe elements of an apparatus in terms of possibility are indefinite and such language will not distinguish the apparatus from the prior art.

Claims 59-64, 66-73, 75 and 76 are also rejected as each depends from either claim 58, 65, 74, and 77-82.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 39-57 and 65-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517 in view of Lewis, U.S. Patent No. 5,612,730.

As per claims 39, 43-47, 50-52, 55, 65, 66, 69-71, 77, 78, 80, and 81, Budow teach client-server communication system comprising:

- specifying a billing preference chosen from a set of billing options that include at least one technique for making a monetary payment (figures 7A-8C)
- transmitting said billing preference to the server system (figures 7A-8C; column/line 12/7-13/10; column/line 24/52-25/28; column 28, lines 30-54)
- receiving a reject or temporary approve signal (or inquiry) from the server system (figures 7A-8C; column 25, lines 28-31, 45-52 and 63-67; column 26, lines 10-13; column 27, lines 10-36)
- a database for storing data, following disconnection of the client system, that identifies each client system, billing information representing an amount of monetary charges accumulated (e.g. data that represents connect time) by said client system (column 7, lines 6-15; column 13, lines 10-13 and 47-49)
- transmitting a rejection from the server system to the client (figures 7A-8B)

- sending periodic connect signals to the server to confirm a connection (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51)

Budow et al. teach a system for providing interactive and information services to users staying at a hotel (column 13, lines 50-53; column 17, lines 20-35) via a server (column/line 8/62-9/50; column 10, lines 8-25; column/line 11/65-12/6; column 17, lines 20-35) that manages a plurality of user terminals (column 9, lines 38-50; column 11, lines 33-46). However, Budow et al. do not specifically recite the internet. Lewis teaches a system for providing information services such as access to the internet (e.g. two-way communication between a client and an electronic communication network) to users staying at a hotel (column 5, lines 15-21; column 6, lines 14-23; column 7, lines 10-36; column 8, lines 36-50). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Budow et al. and Lewis in order to generate additional revenue streams for providing access to the internet.

As per claims 54 and 73, Budow et al. teach receiving a periodic connect signal (i.e. polling response signal to determine if a user is watching a pay-per-view event); providing a clock signal (e.g. polling every two seconds, free preview of event for a limited time such as the first 5 minutes, duration of event, system computer's internal timing mechanism), determining if said periodic signal (i.e. polling signal) is received from the client system within a pre-determined time

period based on said clock signal (i.e. after the allotted time for free viewing) and setting a disconnect parameter (i.e. not processing a bill) if it is determined that said periodic signal (i.e. polling response from client) has not been received from the client within said predetermined period- "no data" or "data" signal is received during the free period (i.e. not received within said predetermined period) (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51).

As per claims 40-42, 48, 49, 67, and 68, "software" is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third Edition, page 441). Examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate". Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). The terminal processes polling data (column 11, lines 40-46; column 14, lines 4-23) and billing data (column 15, lines 26-33; column 21, lines 6-18), and controls reception to the television and interactive services by providing a user with an interface to the server and server applications (column 7, lines 22-38; column 13, lines 50-55). Hence, it is inherent that the Budow et al. terminal (figures 4 and 4A) and system includes software. Further, "pushing" data and "updating" software are old and well-known. Therefore, it would have been obvious to

one of ordinary skill to "push" updates from the server (figure 1, item 4) to the plurality of room terminals in order to expedite the process.

As per claims 53 and 72, Budow et al. teach maintaining a customer portfolio (column 13, lines 10-13) in order to settle a user's bill which includes client identification information (column/line 28/64-29/3). When using a card to settle the bill a hotel processes the checkout by transmitting account billing corresponding to the total amount of monetary charges to the customer's credit card company (i.e. network management system) in order to complete the transaction.

As per claims 55-57, 74-76, 79 and 82, Budow et al. teach providing a set of billing options to a user, receiving a billing preference and sending an approval inquiry to a remote approval system (column/line 26/43-27/58). Budow et al. also teach conducting two-way communications over an electronic network (figure 1 and 7A-8B) and a server receiving a rejection signal from a remote approval system and transmitting a rejection signal from the server to the client (figures 7A-8B; column/line 26/43-27/58). Regarding temporary approval signals, Budow et al. allow users to preview pay-per-view selections (column 11, lines 46-65) therefore, the Budow et al. system sends a "temporary approval signal" to the client system prior to the server system receiving the results from the remote approval system. If the user receives an "insufficient funds" message then, it would have been obvious for a user to no longer seek the ability to view the pay-

preview event, and thus discontinuing two-way communications (figures 7A-8B) between client and server (i.e. server discontinues communications with client). On the other hand, Budow et al. allows for a user to use another card (i.e. additional billing information) if the initial card lacks sufficient funds (claims 57 and 76) (column/line 26/61-27/8).

7. Claims 58-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Budow et al., U.S. Patent No. 5,661,517 in view of Ahmad, U.S. Patent No. 5,565,908 and Lewis, U.S. Patent No. 5,612,730.

As per claims 58 and 62-64, Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60) and said terminal sends periodic connect signals to the server to confirm a connection (column 11, lines 34-65; column 14, lines 4-13; column 24, lines 40-51) and receives temporary approval signals (figures 7A-8B; column 11, lines 46-65). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). Budow et al. do not teach explicitly recite volatile RAM. The RAM of Budow et al. is non-volatile and reserved exclusively for billing. Ahmad teaches a client system comprising a terminal and TV wherein the terminal comprises volatile RAM associated with a processor (column 6,

lines 58-67). However, neither Budow et al. nor Ahmad explicitly recite connecting to the internet. Lewis et al. explicitly recite connecting a user to an electronic communications network such as the internet. Therefore, it would have been obvious to one of ordinary skill to modify the terminal of Budow et al. ('517, figures 4 and 4A) by using the processor board of the Ahmad terminal, in order to more efficiently process data by allowing the processor ('517, figures 4 and 4A) to temporarily store data in the RAM ('908, column 6, lines 65-67) and use EPROM to store control programs for the processor ('908, column 6, lines 65-68), and to modify the system of Budow et al. to provide access to the internet for a fee in order to generate additional revenue streams.

As per claims 59-61, Software is a computer program that makes hardware work (Microsoft Press "Computer Dictionary" Third Edition, page 441). Examples are "system software" that controls the working of a computer and "network software" which enables groups of computers to communicate". Budow et al. teach a client system in communication with a server, where said client system comprises a terminal, television or a terminal-television combination (figure 1; column 14, lines 56-60). The terminal comprises a processor, memory and other hardware devices (figures 4 and 4A). The terminal processes polling data (column 11, lines 40-46; column 14, lines 4-23) and billing data (column 15, lines 26-33; column 21, lines 6-18), and controls reception to the television and interactive services by providing a user with an interface to the server and server

applications (column 7, lines 22-38; column 13, lines 50-55). Hence, it is at least obvious that the Budow et al. terminal (figures 4 and 4A) includes software. Further, "pushing" data and "updating" software are old and well-known. Therefore, it would have been obvious to one of ordinary skill to "push" updates from the server (figure 1, item 4) to the plurality of room terminals in order to expedite the process.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", written over the printed name.

Calvin Loyd Hewitt II
Primary Examiner

October 16, 2006